REMARKS

Claims 1-8,10-12, and 14-35 are pending in the present application. Claims 1-8, 10-12, 14-23, 28-29, 31-32, and 34 have been amended without prejudice and without acquiescence. New claim 35 has been added. Support for the amendments and new claim may be found in the Specification on page 2, lines 7-13, page 2, line 22-page 3, line 14, and page 7, line 26-page 8, line 13. No new matter has been added. Applicants retain the right to file a continuation application to any canceled claims.

The issues outstanding in this application are as follows:

- Claim 4 was objected to as being dependent upon a rejected base claim.
- Claims 1-3, 5-7, 10, 14, 16-18, and 20 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Kashimura et al. (US Pat No. 5326848).
- Claims 1-3, 5-8, 10-12, and 14-34 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hunt et al. (WO 91/09731) in view of Kashimura et al. (US Pat No. 5326848).

Applicants respectfully traverse the outstanding rejections, and Applicants respectfully request reconsideration and withdrawal thereof in light of the amendments and remarks contained herein.

I. Claim 4 Objection

Claim 4 is objected to as being dependent upon a rejected base claim. However, the Examiner states that claim 4 "would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Furthermore, the Examiner states, "[t]he prior art fails to teach polytrimethylene naphthalate as a barrier material." In order to further the prosecution of the present application, Applicants have added claim 35, which, without acquiescence and without prejudice, presents the allowable subject matter in an independent claim.

II. Rejection under 35 U.S.C. § 102(b)

Claims 1-3, 5-7, 10, 14, 16-18, and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kashimura et al. (US Pat No. 5326848). Applicants respectfully traverse.

Anticipation, including inherent anticipation, requires that a single "prior art reference expressly or inherently contain each and every limitation of the claimed subject matter." *Schering Corp. v. Geneva Pharm., Inc.*, 339 F.3d 1373, 1379 (Fed. Cir. 2003) (*citing EMI Group N. America, Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 1350 (Fed. Cir. 2001) ("A prior art reference anticipates a patent claim if the reference discloses, either expressly or inherently, all of the limitations of the claim."); *Verdegaal Bros. Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.")).

In order to more clearly define the inventive subject matter, and without acquiescence and without prejudice, applicants have amended claims 1-3, 5-7, 10, 14, 16-18, and 20. The amended claims clearly cover a product comprising a nicotine-containing-product with a defined packaging material, and methods for making same. This subject matter is not expressly or inherently disclosed in Kashimura. Kashimura makes no reference at all to nicotine; the patent does not mention or suggest the use of the disclosed material for packaging nicotine, and makes no mention of nicotine-containing-products.

For these reasons, Applicants therefore respectfully submit that the claimed subject matter is not anticipated by Kashimura. Applicants thus respectfully request withdrawal of the rejection.

III. Rejection under 35 U.S.C. § 103(a)

Claims 1-3, 5-8, 10-12, and 14-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunt et al. (WO 91/09731) in view of Kashimura et al. (US Pat No. 5326848). Applicants respectfully traverse.

The Examiner acknowledges that Hunt does not teach the claimed polymers. However, the Examiner argues that the claimed subject matter would have been obvious from Hunt combined with Kashimura because, allegedly, Hunt teaches PET packaging for nicotine-containing-products, and Kashimura teaches that its polyesters have better barrier properties than PET. Applicants respectfully disagree.

Applicants assert that claims 1-3, 5-8, 10-12, and 14-34 are not *prima facie* obvious because it is improper to combine references that teach away from the asserted combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Rather than render the claimed subject matter obvious, the combination of Hunt with Kashimura actually teaches away from the claimed subject matter. Hunt does not teach or suggest the use of PET polymers for the effective packaging of nicotine-containing-products. Rather, Hunt distinguishes PET polymers, along with other polymers, from Barex® (a nitrile rubber modified acrylonitrile-methyl acrylate copolymer referred to as "N-MA/B" in Hunt), and teaches that only Barex® is effective for nicotine packaging. For example, the specification states:

> The nicotine barrier layer of this invention comprises a nitrile rubber modified acrylonitrile-methyl acrylate copolymer (hereafter "AN-MA/B").
>
> (page 3, lines 25-27, see also, page 6, lines 1-14).

The specification teaches that Hunt discovered that, unlike what might be expected from the art, only Barex® is effective in packaging nicotine-containing-products, and that other polymers – including PET – are ineffective. For example, the specification states:

> Materials which were known, or could be reasonably expected, to provide a barrier to nicotine and provide protection from nicotine degradation agents include metal foils such as aluminum foil, polyesters such as polyethylene terephthalate (PET) . . . . However, these materials require the use of an adhesive to bond opposing surfaces and we have found that the adhesive itself can provide a path for migration of nicotine out of the package and/or migration of degradation agents into the package.
>
> As a result, prior to our invention, a nicotine containing pouch or package capable of enclosing nicotine in a stable manner, over a long period of time, was not avaliable.
>
> (page 2, lines 14-30).

Further, Examples 1 and 2, and Figure 12, provide comparative data show that only Barex® is an effective for nicotine packaging. The specification states, for example, in Example 2:

> Nicotine migration through the pouches was determined, and is shown in Figure 12. All materials other than the AN-MA/B (Barex®) material showed excessive nicotine migration.
>
> (page 11, lines 9-11 emphasis added).

Furthermore, PET is not even taught or suggested in Hunt for use as a nicotine-relevant material. The invention of Hunt is to a two or three layered material for packaging a nicotine-containing-product. The material requires at least one layer of a "nicotine barrier layer" material which prevents the escape of nicotine from the package (see layers 20, 30, 40, 50, 60, 70, 80 and 100), and one layer of a "nicotine degradation agent barrier" material, which prevents nicotine-degrading agents, such as oxygen, water and light, from entering the package from the surrounding environment (see layers 22, 42, 62 and 102). Barex® is the example of the "nicotine barrier layer." Aluminum foil is an example of a "nicotine degradation agent barrier."

PET is described only as an "optional exterior surface" which can be applied over the nicotine-barrier layers and is useful as decoration and in making the pouch tear-resistant. All

but one of the embodiments in the specification entirely lack this optional protective layer. The specification, for example, states:

> It is also desirable to provide the laminate of this invention with an additional external protective lamina. This lamina is preferably formed from paper or a printable polymer such as polyethylene terephthalate (PET). Use of PET which is tear resistant offers the additional advantage of making the pouch more "child proof." This outer layer provides the finished pouch with a protective coating which prevents damage to the other layers, is attractive, and is a good substrate for printing.
>
> (page 8, lines 2-9, see also, Figures 2 and 3, layer 26).

Finally, while Applicants agree with the Examiner that Kashimura states that its polyesters "have better barrier properties than PET," Applicants assert that in the context of combining Kashimura with Hunt, this statement would lead one skilled in the art away from the instantly claimed invention. As shown above, Hunt teaches that PET is not to be used for packaging nicotine-containing-products. Kashimura teaches "the gas barrier property of PET is very difficult to improve because it has already obtained a considerably high level and that any improvement should not impair the processability into containers . . . ."Applicants assert that faced with the teaching that a certain product does not work in a specific use, and that improvements to the product are expected to be difficult, one skilled in the art would not find it obvious to make the combination to achieve an effective result. Indeed, this proves that the inventive subject matter was unexpected and not obvious over the prior art.

For these reasons, Applicants therefore respectfully submit that the claimed subject matter is not obvious over Hunt combined with Kashimura, and Applicants respectfully request withdrawal of the rejection.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P02232US0 from which the undersigned is authorized to draw.

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Respectfully submitted,

By _____

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